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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/463,549 01/27/00 DENSHAM

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EXAMINER

LUNDGREN, J

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

06/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/463,549

Applicant(s)

DENSHAM, DANIEL HENRY

Examiner

Jeffrey Lundgren

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-21 and 30-34, are drawn to a method for sequencing a polynucleotide with a polymerase enzyme immobilized to a *solid* support.

Group II, claim(s) 22, are drawn to a sensor chip with a polymerase enzyme immobilized thereon.

Group III, claim(s) 23-28 and 35, are drawn to a nucleotide comprising a blocking group at the 3' position.

Group IV, claim(s) 29, are drawn to an apparatus for sequencing a polynucleotide comprising an optical sensor chip.

2. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The invention of Group I does not require the solid substrate to be limited to the sensor chip (i.e., special technical feature) as in Group II. Each of Groups II-IV are patently distinct inventions, wherein each invention comprises materially and functionally different limitations.

Inquiries

3. Any inquiries concerning the *merits* of this communication or earlier communications from the Examiner should be directed to Jeffrey S. Lundgren, whose telephone number is (703) 306-3221. The Examiner can normally be reached on Monday-Friday from 7:00 AM to 5:00 PM (EST).

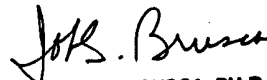
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Michael Woodward, can be reached at (703) 308-4426.

Any inquiries of a *general* nature relating to this application should be directed to Ms. Pauline Farrier, Patent Analyst for Art Unit 1631, whose telephone number is (703) 305-3550.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed to Group 1631 using (703) 308-0294. Please notify the Examiner of incoming facsimiles prior to sending papers to the aforementioned fax number. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).



Jeffrey S. Lundgren, Ph.D.


JOHN S. BRUSCA, PH.D
PRIMARY EXAMINER